



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,432	02/17/2000	John R. Stevens	032795-001	6452
28581	7590	08/02/2005	EXAMINER	
DUANE MORRIS LLP			FRENEL, VANEL	
PO BOX 5203			ART UNIT	
PRINCETON, NJ 08543-5203			PAPER NUMBER	

3626

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/506,432	Applicant(s) STEVENS ET AL.	
	Examiner Vanel Frenel	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,55,56,58-62,64-67,70 and 71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,55,56,58-62,64-67,70 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/08/05 has been entered.

Notice to Applicant

2. This communication is in response to RCE filed on 02/08/05. Claims 2, 57, 63 and 68-69 have been canceled. Claims 16-54 have been withdrawn. Claims 70-71 are newly added. Claims 1, 3-15, 55-56, 58-62, 64-67 and 70-71 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-15, 55-56, 58-62, 64-67 and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman (5,544,044), Johnson et al (4,987,538) and further in view of Shults et al (6,324,516).

(A) As per claim 1, Leatherman discloses a system comprising: software accessed at a provider computer (Col.3, lines 32-67 to Col.4, line 67).

Johnson does not explicitly disclose the software adapted to prompt the provider to input data concerning a workers' compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a workers' compensation claim verification system; and a workers' compensation claims verification system adapted to receive the at least some of the data and to determine therefrom any matching workers' compensation claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to the provider computer, if there is no matching workers' compensation claim number.

However, these features are known in the art, as evidenced by Johnson. In particular, Johnson suggests the software adapted to prompt the provider to input data concerning a workers' compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a workers' compensation claim verification system (See Johnson, Col.2, lines 1-67 to Col.3, line 49); and a workers' compensation claims verification system adapted to receive the at least some of the data and to determine therefrom any matching workers' compensation claim number, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to the provider

Art Unit: 3626

computer, if there is no matching workers' compensation claim number (See Johnson, Col.2, lines 1-67 to Col.3, line 49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Johnson within the system of Leatherman for providing a method for processing provider billings under insurance claims where determination of maximum allowable pay out for a provider billing is controlled by a detailed and complex array of administrative rules (See Johnson, Col.1, line 6-10).

Leatherman and Johnson do not explicitly disclose the workers' compensation claims verification system automatically sends an indication of the lack of determining the workers' compensation claim number to a selected one of a plurality of payer computers.

However, this feature is known in the art, as evidenced by Shults. In particular, Shults teaches the workers' compensation claims verification system automatically sends an indication of the lack of determining the workers' compensation claim number to a selected one of a plurality of payer computers (See Shults, Col.7, lines 15-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Shults within collective teachings of Leatherman and Johnson with the motivation of providing a list of all of the UR agreements which have some probability of applying to a particular line in a medical bill and presents that list visually on-line to a human operator who can chooses to apply any particular UR agreement to all items in a bill, to one item in a bill, or more none of the items in a bill (See Shults, Col.4, lines 31-37).

(B) As per claim 3, Johnson discloses the system wherein the indication is a signal to other software systems co-located with the workers' compensation claims verification system (Col.5, lines 34-67 to Col.6, line 67).

(C) As per claim 4, Johnson discloses the system wherein the workers' compensation claims verification system electronically requests a workers' compensation claim number from a selected one of said plurality of payer computers (Col.2, lines 1-67 to Col.3, line 49).

(E) As per claim 5, Johnson discloses the system wherein the software accessed at the provider computer is part of a workers' compensation medical treatment reporting system (Col.2, lines 1-67 to Col.3, line 49).

(F) As per claim 6, Johnson discloses the system wherein the software accessed at the provider computer is adapted to use the workers' compensation claim number obtained from the Workers' Compensation claim verification system to produce medical treatment reports including the Workers' Compensation claim number (Col.2, lines 1-67 to Col.3, line 49).

(G) As per claim 7, Johnson discloses the system further comprising multiple providers, each having a provider computer, each of the provider computers being

operably connected to the Workers' Compensation claim verification system across the Internet (Col.2, lines 1-67 to Col.3, line 49).

(H) As per claim 8, Johnson discloses the system wherein the Workers' Compensation claim verification system contains claim data for a number of payers (Col.2, lines 1-67 to Col.3, line 49).

(I) As per claim 9, Johnson discloses the system wherein the Workers' Compensation claim verification system is updated with data obtained from payer computers (Col.2, lines 40-67 to Col.3, line 25).

(J) As per claim 10, Leatherman discloses the system wherein at least some of the data sent across the Internet includes name data, social security data, and injury date data (Col.8, lines 18-50).

(K) As per claim 11, Johnson discloses the system wherein the Workers' Compensation claim verification system is adapted to interface with a payer computer to request a Workers' Compensation claim number using a database at a server, and provide the claim number to the provider computer (Col.2, lines 1-68 to Col.3, line 49).

(L) As per claim 12, Johnson discloses the system wherein the Workers' Compensation claim verification system is adapted to receive at least one claim

Art Unit: 3626

numbers from said payer computers; and match the claim numbers with associated claim verification requests (Col.2, lines 1-68 to Col.3, line 49).

(M) As per claim 13, Johnson discloses the system wherein the Workers' Compensation claim verification system is further adapted to receive a plurality of unassigned claim numbers from said payer computers and the Workers' Compensation claim verification system, and assigns claim numbers to injuries from the blocks of unassigned claim numbers in response to claim verification requests received from provider computers (Col.2, lines 1-67 to Col.3, line 49).

(N) As per claim 14, Johnson discloses the system wherein the Workers' Compensation claim verification system includes software that is adapted to allow a provider computer to access a payer computer, and payer computer to access the provider computer, for the purpose of requesting and supplying claim numbers (Col.2, lines 1-67 to Col.3, line 49).

(O) As per claim 15, Johnson discloses the system wherein the Workers' Compensation claim verification system is maintained at selected ones of said plurality of payer computers (Col.2, lines 1-67 to Col.3, line 49).

(P) Claim 55 differs from claim 1 by reciting a system for processing workers' compensation claim information comprising:

As per this limitation, it is noted that Leatherman discloses a computer programmed to accept information, which information may include a corresponding claim number, from a provider of medical services (Col.3, lines 32-67 to Col.4, line 67); said computer operative to transmit a subset of the information, including the corresponding claim number if the claim number is present in the information, to a verification means comprising: a database of workers' compensation information to reconcile workers' compensation billing data required by a recipient of the subset of information (Col.7, lines 49-67 to Col.8, line 67); an associated database, wherein said databases are utilized to determine if the subset of the information includes a valid claim number, and an indicator, the indicator produces an electronic signal that transmitted to a payer computer (See Johnson, Col.5, lines 34-68 to Col.6, line 68) and Shults discloses wherein said databases are utilized to determine if the subset of information includes a valid claim number, and if the subset of information does not include a valid claim number (See Shults, Col.7, lines 15-67).

Thus, it is readily apparent that these prior art systems utilize a system for processing workers compensation claim information to perform their specific function.

The remainder of claim 55 is rejected for the same reason given above for claim 1, and incorporated herein.

(Q) Claim 56 differs from claims 1 and 55 by reciting a method for processing workers' compensation claim information comprising the steps of:

As per this limitation, it is noted that Leatherman discloses inputting information, which information may include a corresponding claim number, from a provider of

Art Unit: 3626

medical services to a suitably programmed computer (Col.3, lines 31-67 to Col.4, line 67); transmitting a subset of the information, including the corresponding claim number if the claim number is present, to a verification means wherein the steps of verification include: accessing a database of workers' compensation to reconcile workers' compensation billing data required by a recipient of the subset of information and an associated database (See Johnson, Col.5, lines 34-68 to Col.6, line 68), and Shults discloses generating an indication if the subset of the information fails to include a valid claim number (See Shults, Col.7, lines 15-67).

Thus, it is readily apparent that these prior art systems utilize a system for processing workers compensation claim information to perform their specific function.

The remainder of claim 55 is rejected for the same reason given above for claim 1, and incorporated herein.

(S) As per claim 58, Johnson discloses the system wherein the electronic signal produced by the indicator is an electronic mail from the system for processing workers compensation claim information to a payer computer (Col.2, lines 1-68 to Col.3, line 49).

(T) As per claim 59, Johnson discloses the system wherein the electronic signal produced by the indicator includes a valid claim number (Col.3, lines 14-49).

Art Unit: 3626

(U) As per claim 60, Johnson discloses the system wherein the electronic signal produced by the indicator is transmitted to the provider of medical services (Col.1, lines13-57)....

(V) As per claim 61, Johnson discloses the system wherein the database contains workers' compensation sufficient to reconcile workers' compensation billing data for one or more recipients (Col.1, lines 13-57; Col.5, lines 34-68 to Col.6, line 68).

(W) As per claim 62, Leatherman discloses the system wherein the database of rules for reconciling billing data required by a plurality of recipients, contains a subset of the rules that are applicable to a corresponding recipient, and the verification means is configured to apply the subset of rules for reconciling billing data required by the corresponding recipient (Col.7, lines 49-67 to Col.8, line 67).

(Y) As per claim 64, Johnson discloses the method wherein the indicator is transmitted to the recipient (Col.2, lines 1-68 to Col.3, line 49).

(Z) As per claim 65, Johnson discloses the method wherein the indicator is transmitted to the provider of medical services (Col.2, lines 1-67 to Col.3, line 49).

(AA) As per claim 66, Johnson discloses the method wherein the database contains workers' compensation information sufficient to reconcile billing data for one or more recipients (Col.1, lines 13-57; Col.5, lines 34-68 to Col.6, line 68).

(BB) As per claim 67, Leatherman discloses the method wherein the database of workers' compensation information contains a hierarchy of rules for reconciling workers' compensation billing data required by a plurality of recipients, wherein a subset of said rules are applicable to a corresponding recipient, and the verification means is configured to apply the subset of rules for reconciling billing data required by the corresponding recipient (Col.7, lines 49-67 to Col.8, line 67).

(CC) As per claim 70, Leatherman discloses a system comprising: software accessed at a provider computer (Col.3, lines 32-67 to Col.4, line 67), the software adapted to: prompt the provider to input data concerning a workers' compensation claim, the software adapted to send an electronic claim number request containing at least some of the data across the Internet to a workers' compensation verification system (See Johnson, Col.2, lines 1-67 to Col.3, line 49).

Leatherman does not explicitly disclose a workers' compensation claims verification system adapted to receive the at least some of the data.

However, this feature is known in the art, as evidenced by Johnson. In particular, Johnson suggests a workers' compensation claims verification system adapted to receive the at least some of the data (See Johnson, Col.5, lines 34-62).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Johnson within the system of Leatherman for providing a method for processing provider billings under insurance claims where determination of maximum allowable pay out for a provider billing is controlled by a detailed and complex array of administrative rules (See Johnson, Col.1, line 6-10).

Leatherman and Johnson do not explicitly disclose determine therefrom a matching workers' compensation claim number associated with said data; and, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to provider computer.

However, these features are known in the art, as evidenced by Shults. In particular, Shults suggests determine therefrom a matching workers' compensation claim number associated with said data (See Shults, Col.7, lines 15-67); and, if there is a matching workers' compensation claim number, the workers' compensation claims verification system is adapted to electronically supply the matching workers' compensation claim number to provider computer (See Shults, Col.4, lines 32-57; Col.7, lines 15-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Shults within collective teachings of Leatherman and Johnson with the motivation of providing a list of all of the UR agreements which have some probability of applying to a particular line in a medical bill and presents that list visually on-line to a human operator who can chooses to apply

any particular UR agreement to all items in a bill, to one item in a bill, or more none of the items in a bill (See Shults, Col.4, lines 31-37).

(DD) As per claim 71, Shults discloses the system wherein if there is no matching workers' compensation claim number, the workers' compensation claims verification system automatically send an indication of the lack of determining the workers' compensation claim number to a selected one of a plurality of payer computers (See Shults, Col.4, lines 31-37).

Response to Arguments

4. Applicant's arguments filed on 02/08/05 with respect to claims 1, 3-15, 55-56, 58-62, 64-67 and 70-71 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches computer system and method for work management (5,182,705).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.


Art Unit: 3626

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

V.F
V.F

May 05, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600